

ESTTA Tracking number: **ESTTA340792**Filing date: **04/05/2010**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	The North Face Apparel Corp
Granted to Date of previous extension	05/01/2010
Address	3411 Silverside Road Wilmington, DE 19810 UNITED STATES

Correspondence information	The North Face Apparel Corp 3411 Silverside Road Wilmington, DE 19810 UNITED STATES turkc@vfc.com
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**Applicant Information**

Application No	77840757	Publication date	03/02/2010
Opposition Filing Date	04/05/2010	Opposition Period Ends	05/01/2010
Applicant	South Butt, LLC, The Suite 404 7710 Carondelet Clayton, MO 63105 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 025. First Use: 2007/05/00 First Use In Commerce: 2007/05/00 All goods and services in the class are opposed, namely: Jackets; Shirts; Shorts
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**Grounds for Opposition**


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3538773	Application Date	01/23/2006
Registration Date	11/25/2008	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		


Design Mark	
Description of Mark	The mark consists of the literal element "THE NORTH FACE" in white letters in a solid red square, with the design element consisting of three arcs emanating from the right of each word.
Goods/Services	<p>Class 009. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Computer bags</p> <p>Class 018. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 All purpose sporting bags, backpacks, day packs, knapsacks, rucksacks, book bags, tote bags, handbags, duffel bags, knap sacks and duffel sacks, messenger bags, hip and lumbar packs, hip belts, shoulder bags, messenger bags, book bags, waist packs, fanny packs, day packs, shoulder bags, satchels, mountaineering bags, Boston bags, internal frame packs and external frame packs, backpack bottle pockets, rain covers used to cover the aforesaid; hydration packs, namely, backpack hydration systems consisting of a backpack, a reservoir, and a mouthpiece connected to the reservoir by a tube; backpack shoulder harnesses; parts and fittings for all the aforesaid goods; walking sticks, alpenstocks, umbrellas, and parasols</p> <p>Class 020. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Sleeping bags; covers for sleeping bags; sleeping bag pads; sleeping bag liners; sacks for carrying and storing sleeping bags; non-metal tent poles and tent stakes</p> <p>Class 021. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Hydration packs, namely, hydration system consisting of a reservoir and a mouthpiece connected to the reservoir by a tube</p> <p>Class 022. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Tents; tent accessories, namely, tent storage bags, rain flies, vinyl ground cloths, tent pole storage sacks, and gear loft platforms used for storage</p> <p>Class 025. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 Clothing, namely, men's, women's, and children's T-shirts, shirts, tops, sweatshirts, sweatpants, pants, side zip pants, shorts, trousers, jeans, vests, parkas, anoraks, coats, jackets, wind-resistant jackets, jacket hoods, pullovers, sweaters, coveralls, underwear, thermal underwear, boxer briefs, sleepwear, lingerie, loungewear, hosiery, socks, tights, gloves, mittens; outerwear, namely, shells, one-piece shell suits, ski wear, ski suits, ski vests, ski jackets, ski bibs, bib overalls, bib pants, snowboard wear, snow pants, snow suits, rain wear, rain jackets, rain pants, gaiters, namely, neck gaiters, leg gaiters and ankle gaiters; skirts, skorts, dresses, swimsuits, swim trunks; footwear, namely, athletic shoes, sneakers, trail running shoes, climbing shoes, hiking shoes, slippers, climbing slippers, boots, trekking boots, hiking boots, snowshoes, clogs, sandals; headgear, namely, caps, hats, headbands, bandanas, scarves, earbands, earmuffs, balaclavas, visors, beanies; belts</p> <p>Class 035. First use: First Use: 1989/01/25 First Use In Commerce: 1989/01/25 On-line retail store services, retail store services, mail order, catalogue and distributorship services, all featuring camping and outdoor gear and equipment,</p>


	books, food, hardware, clothing, sportswear, eyewear, footwear, headgear, sports equipment and related accessories
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U.S. Registration No.	3630846	Application Date	10/24/2008
Registration Date	06/02/2009	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		
Design Mark			
Description of Mark	The mark consists of the stylized literal element "THE NORTH FACE", with the word "THE" appearing above the word "NORTH", the word "NORTH" appearing above the word "FACE", and the design element consisting of three solid arcs, with one arc emanating from the right of each word.		
Goods/Services	Class 025. First use: First Use: 1968/01/06 First Use In Commerce: 1968/01/06 Footwear; Head wear; Rainwear; Scarves; Ski wear; Socks; Socks and stockings		

U.S. Registration No.	3630565	Application Date	10/16/2008
Registration Date	06/02/2009	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		
Design Mark			
Description of Mark	The mark consists of the word "THE NORTH FACE" with half-dome design made of three bended bands all in a horizontal layout.		
Goods/Services	Class 025. First use: First Use: 2003/07/25 First Use In Commerce: 2003/07/25 Footwear		

U.S. Registration No.	2300758	Application Date	02/25/1998
Registration Date	12/14/1999	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/06/00 First Use In Commerce: 1998/06/00 Shoes

U.S. Registration No.	2097715	Application Date	10/03/1996
Registration Date	09/16/1997	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1971/12/00 First Use In Commerce: 1971/12/00 backpacks Class 020. First use: First Use: 1971/12/00 First Use In Commerce: 1971/12/00 sleeping bags Class 022. First use: First Use: 1971/12/00 First Use In Commerce: 1971/12/00 tents Class 025. First use: First Use: 1971/12/00 First Use In Commerce: 1971/12/00 clothing, namely, parkas, vests, jackets, anoraks, pants, ski bibs, gloves, mittens, underwear, hats, headbands, caps, ski suits, gaiters, shorts, shirts and belts		

U.S. Registration No.	983624	Application Date	06/12/1972
Registration Date	05/14/1974	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class U003 (International Class 022). First use: First Use: 1968/06/00 First Use In Commerce: 1969/03/10  BACKPACKS</p> <p>Class U022 (International Class 028). First use: First Use: 1968/06/00 First Use In Commerce: 1969/03/10  SLEEPING BAGS, TENTS, SNOWSHOES, AND SKIS</p> <p>Class U039 (International Class 025). First use: First Use: 1968/06/00 First Use In Commerce: 1969/03/10  CAMPING CLOTHING-NAMELY, RAINWEAR, PARKAS, VESTS, TROUSERS, SHOES, GLOVES AND HEADGAR</p>

Attachments	<p>78797140#TMSN.jpeg ( 1 page )( bytes )  77600179#TMSN.jpeg ( 1 page )( bytes )  77594171#TMSN.jpeg ( 1 page )( bytes )  75440262#TMSN.gif ( 1 page )( bytes )  75176107#TMSN.gif ( 1 page )( bytes )  Not of Opp.pdf ( 7 pages )(1125539 bytes )</p>
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/cmt/
Name	The North Face Apparel Corp
Date	04/05/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In re:** U.S. Application Serial No. 77/840,757

**Mark:** THE SOUTH BUTT

**Published:** March 2, 2010

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THE NORTH FACE APPAREL CORP.,

Opposition No.

Opposer,

-against-

THE SOUTH BUTT, LLC,

Applicant.




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**NOTICE OF OPPOSITION**

The North Face Apparel Corp. (“Opposer”) believes that it will be damaged by the registration of the above-identified trademark and hereby opposes the registration thereof and alleges as follows:

**FACTS**

1. Opposer is a corporation organized and existing under the laws of the state of Delaware, having a place of business at 3411 Silverside Rd., Wilmington, Delaware 19810.
2. Opposer, its predecessors in interest and associated companies have, themselves and through licensees, sold high quality technical and casual outdoor apparel and equipment (Opposer’s Products”) for more than forty (40) years.
3. Opposer’s Products are marketed and sold primarily under THE NORTH FACE mark and “Half Dome Design” (Opposer’s Marks).
4. Opposer’s Marks are subject to the following valid and subsisting United States registrations on the Principal Register, most of which have become incontestable:

TRADEMARK	REG. NO.	REG. DATE	GOODS
	3538773	November 25, 2008	<p><b>Class 9:</b> Computer bags.</p> <p><b>Class 18:</b> All purpose sporting bags, backpacks, day packs, knapsacks, rucksacks, book bags, tote bags, handbags, duffel bags, knap sacks and duffel sacks, messenger bags, hip and lumbar packs, hip belts, shoulder bags, messenger bags, book bags, waist packs, fanny packs, day packs, shoulder bags, satchels, mountaineering bags, Boston bags, internal frame packs and external frame packs, backpack bottle pockets, rain covers used to cover the aforesaid; hydration packs, namely, backpack hydration systems consisting of a backpack, a reservoir, and a mouthpiece connected to the reservoir by a tube; backpack shoulder harnesses; parts and fittings for all the aforesaid goods; walking sticks, alpenstocks, umbrellas, and parasols.</p> <p><b>Class 20:</b> Sleeping bags; covers for sleeping bags; sleeping bag pads; sleeping bag liners; sacks for carrying and storing sleeping bags; non-metal tent poles and tent stakes.</p> <p><b>Class 21:</b> Hydration packs, namely, hydration system consisting of a reservoir and a mouthpiece connected to the reservoir by a tube.</p> <p><b>Class 22:</b> Tents; tent accessories, namely, tent storage bags, rain flies, vinyl ground cloths, tent pole storage sacks, and gear loft platforms used for storage.</p> <p><b>Class 25:</b> Clothing, namely, men's, women's, and children's T-shirts, shirts, tops, sweatshirts, sweatpants, pants, side zip pants, shorts, trousers, jeans, vests, parkas, anoraks, coats, jackets, wind-resistant jackets, jacket hoods, pullovers, sweaters, coveralls, underwear, thermal underwear, boxer briefs, sleepwear, lingerie, loungewear, hosiery, socks, tights, gloves, mittens; outerwear, namely, shells, one-piece shell suits, ski wear, ski suits, ski vests, ski jackets, ski bibs, bib overalls, bib pants, snowboard wear, snow pants, snow suits, rain wear, rain jackets, rain pants, gaiters, namely, neck gaiters, leg gaiters and ankle gaiters; skirts, skorts, dresses, swimsuits, swim trunks; footwear, namely, athletic shoes, sneakers, trail running shoes, climbing shoes, hiking shoes, slippers, climbing slippers, boots, trekking boots, hiking boots, snowshoes, clogs, sandals; headgear, namely, caps, hats, headbands, bandanas, scarves, earbands, earmuffs, balaclavas, visors, beanies; belts.</p> <p><b>Class 35:</b> On-line retail store services, retail store services, mail order, catalogue and distributorship services, all featuring camping and outdoor gear and equipment, books, food, hardware, clothing, sportswear, eyewear, footwear, headgear, sports equipment and related accessories.</p>
	3630846	June 2, 2009	<p><b>Class 25:</b> Footwear; Head wear; Rainwear; Scarves; Ski wear; Socks; Socks and stockings.</p>
	3630565	June 2, 2009	<p><b>Class 25:</b> Footwear.</p>

TRADEMARK	REG. NO.	REG. DATE	GOODS
	2300758	December 14, 1999	<u>Class 25</u> : Shoes
	2097715	September 16, 1997	<u>Class 18</u> : Backpacks. <u>Class 20</u> : Sleeping bags. <u>Class 22</u> : Tents. <u>Class 25</u> : Clothing, namely, parkas, vests, jackets, anoraks, pants, ski bibs, gloves, mittens, underwear, hats, headbands, caps, ski suits, gaiters, shorts, shirts and belts.
THE NORTH FACE	0983624	May 14, 1974	<u>Class 22</u> : Backpacks <u>Class 28</u> : Sleeping bags, tents, snowshoes, and skis. <u>Class 25</u> : Camping clothing-namely, rainwear, parkas, vests, trousers, shoes, gloves and headgear.

5. Since at least as early as 1968, Opposer has used Opposer's Marks on or in connection with Opposer's Products.

6. Opposer has made a substantial investment in advertising and promoting Opposer's Products in a wide variety of media.

7. Opposer's marketing efforts, combined with its attention to quality, design and construction of its products, have resulted in substantial sales worldwide.

8. By virtue of a long history of use throughout the world and in the United States, and Opposer's sales and promotional activities, Opposer's Mark has generated valuable goodwill and reputation and have become inherently distinctive of Opposer's Products.

9. Through prolonged and continuous usage, Opposer's Mark has come to be known amongst the consuming public as a symbol of ultimate quality and reliability.



10. Upon information and belief, Applicant The South Butt, LLC, is a limited liability company organized and existing under the laws of the state of Missouri, having an office at 7710 Carondelet, Suite 404, Clayton, Missouri 63105.

11. Applicant is engaged in the manufacture, advertisement, distribution, offer for sale and/or sale of fleece jackets, T-shirts, and other apparel (“Applicant’s Products”).

12. Applicant’s Products are marketed and sold under several trademarks, including THE SOUTH BUTT.

13. On or about October 6, 2009, Applicant filed Trademark Application Serial No. 778407572 (the “Application”) for registration of the mark THE SOUTH BUTT (“Applicant’s Mark”), pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), for the following goods: jackets, shirts and shirts in International Class 25.

14. Applicant’s Mark was published in the Official Trademark Gazette for opposition on or about March 2, 2010.

15. The Application states that Applicant commenced use of Applicant’s Mark in commerce since at least as early as May 2007.

16. Applicant maintains a retail website available on the World Wide Web with an Internet address resolving at the URL <<http://www.thesouthbutt.com>> (the “South Butt Website”).

17. Applicant Products are marketed and sold on the South Butt Website.

18. Applicant markets and uses Applicant’s Mark on or in connection with Applicant’s Products in the following manner:



19. Applicant's Mark is the direct opposite in its connotation to Opposer's Mark.

20. Upon information and belief, Applicant has intentionally adopted and used Applicant's Mark based on its knowledge of Opposer's Marks.

#### **COUNT I** **LIKELIHOOD OF CONFUSION**

21. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 18 herein.

22. Opposer's Mark is famous in the United States and through out the world.

23. The commercial impression created by Applicant's Mark is similar to that of Opposer's Mark.

24. The goods identified in the Application are identical and or similar or related to the goods with which Opposer is using Opposer's Mark.

25. The goods identified in the Application are identical and or similar or related to the goods with which Opposer's Mark is registered.

26. Registration of Applicant's Mark is likely to cause confusion, mistake, or deception as to the source of Applicant's goods and is likely to falsely suggest a common association, sponsorship or origin of said goods between Applicant and Opposer.

**COUNT II**  
**DILUTION**

27. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 22 herein.

28. Through Opposer's extensive advertisement and promotion and substantial sales, Opposer's Mark has become famous.

29. Upon information and belief, any use by Applicant of Applicant's Mark has or will occur after Opposer's Mark became famous.

30. Applicant's Mark is likely to blur and or tarnish the positive associations of Opposer's Mark.

31. Thus, if Applicant is permitted to register and use Applicant's Mark, it is likely to cause dilution of the distinctive quality of Opposer's Mark.

W H E R E F O R E, Opposer prays that, the Board sustain the Opposition and refuse the registration of Applicant's Mark.

Respectfully submitted,

THE NORTH FACE APPAREL CORP.

Dated: April 5, 2010

By:           /CMT/            
Christopher M. Turk  
Assistant Secretary and Senior Counsel  
3411 Silverside Road  
200 Hanby Building  
Wilmington, DE 19810  
(302) 477-3930 x232  
(302) 477-3930 fax

**CERTIFICATE OF SERVICE**

I hereby certify that on this 5<sup>th</sup> day of April, 2010, the foregoing NOTICE OF OPPOSITION was served upon Applicant by delivering same to the following counsel of record, via First Class Mail:

MORRIS E. TUREK  
YOURTRADEMARKATTORNEY.COM  
167 LAMP AND LANTERN VLG # 220  
CHESTERFIELD, MO 63017-8208

/CMT/  
Christopher M. Turk